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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,390	07/05/2001	Dale Francis Obeshaw	H-199376	3506

7590 11/21/2003

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/21/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/899,390

Applicant(s) 012

OBESHAU, DALE FRANCIS

Examiner

Michael C. Miggins

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-14 and 30-34.Claim(s) withdrawn from consideration: 15-29.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attachment

Continuation of 3. Applicant's reply has overcome the following rejection(s): The 112 2nd paragraph rejections set forth in paper #10, page 3, paragraphs 5-8.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

Applicant's arguments with regards to the 35 USC 112 2<sup>nd</sup> paragraph rejections of paper #10, page 3, paragraphs 5-8 have been carefully considered but are moot since the rejections have been withdrawn.

Applicant has traversed all of the double patenting, 102(b) and 103(a) rejections set forth in paper #10. All of applicant's arguments refer to the Erwin reference and applicant has repeated the same arguments for all of the double patenting, 102(b) and 103(a) rejections set forth in paper #10 with regards to the Erwin reference.

With regards to the Erwin reference, applicant has argued that Erwin does not teach a composite overwrap and that the composite overwrap reduces a secondary loading condition on a portion of the outer surface of the structural member. However, Erwin does indeed teach a composite overwrap (since the reinforcing strips 44 from Figs. 3-4 and column 4, lines 3-28 is coated with binder; therefore, the reinforcing strips comprise the material of the binder and reinforcing strips, thus constituting a composite overwrap). Furthermore, the limitation "...the composite overwrap reduces a secondary loading condition on a portion of the outer surface of the structural member ..." is an intended use and has been given little to no patentable weight. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant has argued that the instant specification discloses that the composite overwrap contains fibers that are oriented circumferentially around the composite member (instant specification, paragraph [36]). However, such a limitation is not recited in the independent claims.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., fibers in the composite layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues further that the office has not shown that the longitudinal reinforcing strips 44 of Erwin et al. are a composite overwrap nor has the office shown that the longitudinal reinforcing strips of Erwin et al. reduce secondary loading. However, Erwin does indeed teach a composite overwrap (since the reinforcing strips 44 from Figs. 3-4 and column 4, lines 3-28 is coated with binder; therefore, the reinforcing strips comprise the material of the binder and reinforcing strips, thus constituting a composite overwrap). Furthermore, the limitation "...the composite overwrap reduces a secondary loading condition on a portion of the outer surface of the structural member ..." is an intended use and has been given little to no patentable weight. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant has argued that the office has not shown that a composite overwrap which reduces a secondary loading condition on a portion of the outer surface of the structural member is obvious over Erwin. However, Erwin teaches a composite overwrap as described above and Erwin was used as a 102 reference so a discussion of obviousness is not needed at this time with regards to Erwin.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *MC M*  
November 18, 2003

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*11/19/03*